

**FOLEY**

04-16-04

FOLEY & LARDNER LLP  
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DA C  
#9

April 15, 2004

**RECEIVED**

APR 20 2004

**OFFICE OF PETITIONS**



WRITER'S DIRECT LINE  
414.297.5776  
jwilke@foley.com EMAIL

CLIENT/MATTER NUMBER  
061300-0242

Examiner Sherry D. Brinkley  
Office of Petitions  
Office of Deputy Commissioner for Patent Examination Policy  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**CERTIFICATE OF EXPRESS MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service's "Express Mail Post Office To Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and is addressed to: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.

EV 431598117 US

4/15/04

(Express Mail Label Number)

(Date of Deposit)

Lori A. Wilson  
(Printed Name)

*Lori A. Wilson*  
(Signature)

Re: Petition Pursuant to 37 C.F.R. §1.47(a)  
U.S. Patent Application No.: 09/954,677  
Filing Date: 09/15/2001  
Title: ENVIRONMENTAL SHIELD FOR A TRUCK MOUNTED  
CONCRETE MIXER  
Inventor(s): O'Connell, et al  
Our Ref.: 061300-0242

Dear Ms. Brinkley:

The material attached to this letter is supplemental to the Petition previously filed in the subject case relating to the non-signing inventor, Jack Harowitz. In accord with our telephone conversation, we are enclosing material to confirm that the documentation relating to the subject application was sent to the three individual inventors, specifically Jack Harowitz on or about December 23, 2003. The material was forwarded by United Parcel Service. The material forwarded to Mr. Harowitz includes an instruction letter from Attorney Brad Bauknecht, counsel for Oshkosh Truck Corporation. Also enclosed is the shipment receipt and package tracking information from UPS as well as a letter from Attorney Bauknecht dated April 13, 2004 which indicates that a subsequent phone conversation with UPS confirmed that the package containing the Declaration, Power of Attorney and Assignment of the subject application was delivered to the address of Mr. Harowitz and left at that address.

We believe that the enclosed information satisfies the proof that the non-signing inventor could not be reached or refused to sign after having been presented with the application papers. Accordingly, we respectfully request that you reconsider the Petition and withdraw your decision refusing status under 37 C.F.R. §1.47(a). We have enclosed a copy of your decision refusing status which was mailed on April 1, 2004.

001.1613442.1

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WEST PALM BEACH



April 15, 2004  
Page 2

If you have any questions with respect the enclosed, please contact the undersigned directly

Very truly yours,

A handwritten signature in cursive script that reads "James A. Wilke".

James A. Wilke  
Reg. No: 34,279

Enclosure(s)

cc: Bradford L. Bauknecht (w/o encl.)

**United Parcel Service****Shipment Receipt**

(Keep this for your records.)

**Transaction Date** 23 Dec 2003**Address Information****Ship To:**Jack Harowitz  
6331 East Rochelle Street  
MESA AZ 85215-0709**Shipper:**Oshkosh Truck Corporation  
Brad Bauknecht  
2307 Oregon Street  
Legal  
OSHKOSH WI 54902**Ship From:**Oshkosh Truck Corporation  
Lori Mackey  
9202359151 x2900  
2307 Oregon Street  
Legal  
Oshkosh WI 54902**Shipment Information****Service:**

UPS 2nd Day Air

**\*Guaranteed By:**

End of Day, Fri. 26 Dec. 2003

**Shipping:**

\*\*10.35

**Package Information****Package 1 of 1**

Tracking Number:	1Z5828220298240435
Package Type:	UPS PAK
Actual Weight:	1.0 lb
Billable Weight:	1.0 lb
Reference #1:	11390

**Billing Information****Payment Method:**

Bill Sender: 582822

**Total:**

All currencies in USD

\*\*10.35

Note: The displayed rate is for reference purposes and does not include applicable taxes.

\* For delivery and guarantee information, see the UPS Service Guide. To speak to a customer service representative, call 1-800-PICK-UPS for domestic services and 1-800-782-7892 for international services.

\*\* Rate includes a fuel surcharge.

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Unless a greater value is recorded in the insured value field as appropriate for the UPS shipping system used, the shipper agrees that the released value of each package covered by this receipt is no greater than \$100, which is a reasonable value under the circumstances surrounding the transportation. UPS does not accept for transportation and shipper's requesting service through the Internet are prohibited from shipping packages with a value of more than \$50,000. The maximum liability per package assumed by UPS shall not exceed \$100, regardless of the purchase of insurance for protection in excess of \$100. The maximum liability per package assumed by the applicable insurance company shall not exceed \$50,000 (less \$100). Claims not made within nine months after delivery of the package (six months for international shipments), or in the case of failure to make delivery, nine months after a reasonable time for delivery has elapsed (six months for international shipments), shall be deemed waived. The entry of a C.O.D. amount is not a declaration of value for insurance purposes. All checks or other negotiable instruments tendered in payment of C.O.D.'s will be accepted by UPS at shipper's risk. UPS shall not be liable for any special, incidental, or consequential damages.

All shipments are subject to the terms and conditions contained in the UPS Tariff and the UPS Terms and Conditions of Service, which can be found at [www.ups.com](http://www.ups.com).

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To view Proof of Delivery, please select the link.

**Status:** Delivered [Proof of Delivery](#)  
**Delivered on:** Dec 26, 2003 2:49 P.M.  
**Location:** FD POST  
**Delivered to:** MESA, AZ, US  
**Shipped or Billed on:** Dec 23, 2003

**Tracking Number:** 1Z 582 822 02 9824 043 5  
**Service Type:** 2ND DAY AIR  
**Weight:** 1.00 Lb

[Information and services provided to My UPS users.](#)

Have problems or questions about your package?

If you have questions about one of your packages, you can find more information with this special UPS serv

[Request More Information](#)**Package Progress:**

Date	Time	Location	Activity
Dec 26, 2003	2:49 P.M.	TEMPE, AZ, US	DELIVERY
Dec 23, 2003	10:31 A.M.	US	BILLING INFORMATION RECEI

Tracking results provided by UPS: Apr 6, 2004 11:17 A.M. Eastern Time (USA)

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To see a detailed report for each package, please select the "Detail" link.

**Tired of Re-Typing Tracking Numbers?**

Select "Save Tracking Numbers" to easily track packages in the future.

[Save Tracking Numbers](#)

Tracking Number	Status	Delivery Information	
1. 1Z 582 822 02 9824 043 5	Delivered	Delivered on:	Dec 26, 2003 2:49 P
<a href="#">Detail</a>		Delivered to:	MESA, AZ, US
		Service Type:	2ND DAY AIR

Tracking results provided by UPS: Apr 6, 2004 11:16 A.M. Eastern Time (USA)

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**DELIVERY NOTIFICATION**

Dear Customer,

This is in response to your request for delivery information concerning the shipment listed below.

**Tracking Number:** 1Z 582 822 02 9824 043 5  
**Service Type:** 2ND DAY AIR  
**Package Weight:** 1.00 Lb  
**Shipped or Billed on:** Dec 23, 2003  
**Delivered on:** Dec 26, 2003 2:49 P.M.  
**Delivered to:** MESA, AZ, US  
**Location:** FD POST

Thank you for giving us this opportunity to serve you.

Sincerely,  
United Parcel Service

Tracking results provided by UPS: Apr 6, 2004 11:18 A.M. Eastern Time (USA)



## United Parcel Service

## Shipment Receipt

(Keep this for your records.)

Transaction Date 23 Dec 2003

## Address Information

**Return To:**  
Oshkosh Truck Corporation  
Brad Bauknecht  
2307 Oregon Street  
Legal  
OSHKOSH WI 54902**Shipper:**  
Oshkosh Truck Corporation  
Lori Mackey  
9202359151 x2900  
2307 Oregon Street  
Legal  
Oshkosh WI 54902**Pickup From:**  
Jack Harowitz  
6331 East Rochelle Street  
Mesa AZ 85215

## Shipment Information

<b>Return Service:</b>	UPS Returns <sup>SM</sup> Print Return Label .....	0.50
<b>Service:</b>	UPS 2nd Day Air	
<b>Shipping:</b>	.....	<b>**8.83</b>

## Package Information

<b>Package 1 of 1</b>	
Tracking Number:	1Z5828228798880451
Package Type:	UPS Letter
Actual Weight:	Letter
Billable Weight:	Letter
Merchandise Description:	documents
Reference# 1:	11390

## Billing Information

<b>Payment Method:</b>	Bill Sender: 582822	
<b>Total:</b>	All currencies in USD	<b>**9.33</b>

Note: The displayed rate is for reference purposes and does not include applicable taxes.

\* For delivery and guarantee information, see the UPS Service Guide. To speak to a customer service representative, call 1-800-PICK-UPS for domestic services and 1-800-782-7892 for international services.

\*\* Rate includes a fuel surcharge.

## Responsibility for Loss or Damage

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**Track by Tracking Number****View Details**

**Status:** Billing Information Received  
**Shipped to:** MESA, AZ, US

**Tracking Number:** 1Z 582 822 87 9888 045 1

**Service Type:** 2ND DAY AIR

**Note:** UPS has received shipper's billing information electronically. Billing information received not indicate shipment pickup or drop-off. Please contact the shipper for more details.

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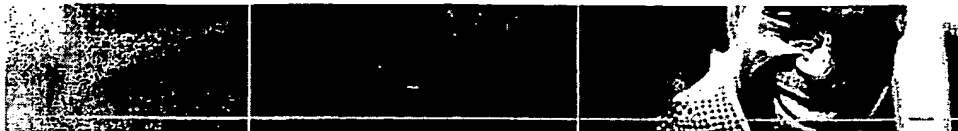
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**Tracking Number****Status****Delivery Information**

1. 1Z 582 822 87 9888 045 1

[Detail](#)

**Billing  
Information  
Received\***

Shipped to: MESA, AZ, US  
Service Type: 2ND DAY AIR



\*UPS has received shipper's billing information electronically. Billing information received does not indicate shipment pickup or drop-off. Please contact the shipper for more details.

Tracking results provided by UPS: Apr 6, 2004 11:19 A.M. Eastern Time (USA)

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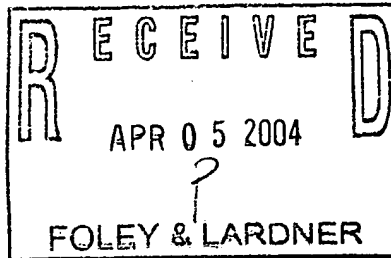
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FOLEY & LARDNER  
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Milwaukee, WI 53202-5367

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APR 01 2004

**OFFICE OF PETITIONS**

In re Application of :  
William J. O'Connell, Michael B. Calhoun :  
and Jack Harowitz :  
Application No. 09/954,677 :  
Filed: September 15, 2001 :  
For: ENVIRONMENTAL SHIELD FOR :  
A TRUCK MOUNTED CONCRETE :  
MIXER :

DECISION REFUSING STATUS  
UNDER 37 CFR 1.47(a)

(REQ. FOR RECONSIDERATION)  
RESPONSE DUE 6/1/04  
1 MO LATE 5/1/04

This is in response to the petition under 37 CFR 1.47(a) filed March 16, 2004.

A review of the record discloses that the above-identified application was filed on September 16, 2001 without an executed oath or declaration and naming William J. O'Connell, Michael B. Calhoun and Jack Harowitz as joint inventors. On October 16, 2001, a "Notice to File Missing Parts of Application" was mailed requiring an executed oath or declaration, filing fee and requisite surcharge. Since no response was filed, a Notice of Abandonment was mailed on November 10, 2003. In response, on January 9, 2004, applicant filed a petition to revive under 37 CFR 1.137(b), the requisite filing fee and surcharge and a partially executed declaration. The petition was dismissed in a decision mailed January 27, 2004. On March 16, 2004, the present petition under 37 CFR 1.47(a) was filed.

The petition is DISMISSED.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks items (1) set forth above.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies

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noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Any extensions of time will be governed by 37 CFR 1.136(a).

As to item (1) applicant has demonstrated that Mr. O'Connell has received that application papers and refused to sign. However, the petition is defective as it relates to Mr. Harowitz, who purportedly cannot be reached. Rule 47 applicant has simply stated that inquiries were made regarding Mr. Harowitz' whereabouts and calls were made, for which there were no answers. Applicant does not state that a copy of the application papers was sent to the last known address of Mr. Harowitz. Accordingly, a copy of the application papers should be sent to the last known address of Mr. Harowitz with a request that he sign the declaration for the patent application. A forwarding address should be requested. If the papers are returned, and other attempts to locate the inventor, e.g. through e-mail or the telephone continue to fail, then applicant will have established that the inventor cannot be reached.

Further correspondence with respect to this matter should be addressed as follows:

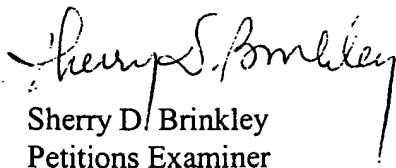
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By Hand:                     2011 South Clark Place  
                                 Crystal Plaza Two, Lobby  
                                 Room 1B03  
                                 Arlington, VA 22202

**The centralized facsimile number is (703) 872-9306.**

The decision on the petition to revive under 37 CFR 1.137(b) will be held in abeyance pending timely resolution of the 37 CFR 1.47(a) matter.

Any questions concerning this matter may be directed to the undersigned at (703) 305-9220.



Sherry D. Brinkley  
Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
For Patent Examination Policy

OSHKOSH TRUCK CORPORATION

---

2307 OREGON STREET (54902)  
POST OFFICE BOX 2566  
OSHKOSH, WISCONSIN 54903-2566  
920-235-9151

Direct Dial No. 920-236-6846  
Fax No. 920-233-9231

December 23, 2003

Mr. William J. O'Connell  
5548 Southern Hills Drive  
Frisco, TX 75034

Mr. Michael B. Calhoun  
1006 Magnolia Drive  
Carrollton, TX 75007

✓ Mr. Jack Harowitz  
6331 East Rochelle Street  
Mesa, AZ 85215

Re: U.S. Patent Application  
ENVIRONMENTAL SHIELD FOR A TRUCK MOUNTED CONCRETE MIXER

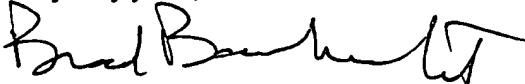
Gentlemen:

Enclosed are a Declaration and Power of Attorney and Assignment-Worldwide in connection with the above-referenced patent application.

Please read, sign and date the documents at the colored tags. The Assignment must also be notarized. By executing the documents, you will be verifying the originality of the invention and acknowledging your duty to disclose to the U.S. Patent and Trademark Office any information of which you are aware that could be material to the examination of the application. Material information could include patents, brochures and other publications (including those authored by a competitor, inventor, or co-worker), published industry standards, as well as information on possible prior uses of the invention, prior sales or offers to sell the invention, prior knowledge of the invention by others, prior invention by another, inventorship conflicts, and the like. This duty of disclosure is an important requirement of the law, and continues throughout the entire prosecution of the patent application until the application issues as a patent. Note that the Declaration is signed under penalty of perjury, so careful consideration should be paid to its contents before signing.

Your prompt return of the executed documents in the enclosed UPS envelope will be appreciated.

Very truly yours,



Bradford L. Bauknecht  
Assistant General Counsel and Compliance  
Manager

BLB:cd  
Encs.

